UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte TRAVIS J. PARRY

_____

Appeal 2008-005561
Application 10/006,637
Technology Center 2400

_____

Decided: January 5, 2010

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Before JEAN R. HOMERE, JOHN A. JEFFERY, and STEPHEN C. SIU,
Administrative Patent Judges.

SIU, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the
Examiner's rejection of claims 7-15, 21, 23, 24, 26, and 27. Claims 1-6, 16-
20, 22, and 25 have been cancelled. We have jurisdiction under 35 U.S.C.
§ 6(b). We reverse.

The Invention

The disclosed invention relates generally to gathering and generating printing error information for a number of printers and conveying the information to an online error message database (Spec. 3).

Independent claim 7 is illustrative:

> 7. A method of collecting information on printer errors over a network, comprising:
>
> providing a printer incorporating a web server, said printer comprising a error detector for detecting errors in printing functions;
>
> attaching said printer to a network, such that said web server is linked to said network;
>
> providing at least one receiving computer in communication with said network, said at least one receiving computer including at least one online error database stored within a memory therein, said at least one online error database capable of receiving an error message generated by said printer and conveyed over said network;
>
> conveying a print job over said network to said printer;
>
> receiving said print job at said printer;
>
> examining said print job for transmittal errors with said error detector;
>
> detecting transmittal errors in said print jobs which contain transmittal errors;
>
> generating a transmittal error message containing details of said transmittal errors;
>
> conveying said transmittal error message over said network with said web server automatically in response to detection of the transmittal error;
>
> receiving said transmittal error message into said at least one online error database by said receiving computer.

The Reference

The Examiner relies upon the following reference as evidence in
support of the rejections:

Bernklau-Halvor   US 6,782,495 B2   Aug. 24, 2004

The Rejections

1. The Examiner rejects claims 7-15, 21, 23, 24, 26, and 27 under 35
   U.S.C. § 112, first paragraph, as failing to comply with the written
   description requirement.[1]
2. The Examiner rejects claims 21 and 26 under 35 U.S.C. § 102(e) as
   being anticipated by Bernklau-Halvor.

ISSUE 1

Appellant asserts that "the specification does indeed provide support
for the recitation that the error messages are 'automatically conveyed over
the network with a web server in response to detection of the . . . error'"
(App. Br. 11).

Did Appellant demonstrate that the Examiner erred in finding that the
Specification lacks written description support of automatically conveying
an error message over a network in response to detection of the error?

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[1] The Examiner rejects claims 7, 8, 9, 21, 26, and 27 under 35 U.S.C. § 112,
first paragraph. Since claims 10-15, 23, and 24 depend from claim 7, 8, or 9
and therefore recite the same disputed feature as claims 7, 8, or 9, we assume
the Examiner likewise rejects claims 10-15, 23, and 24 for the same reasons.

ISSUE 2

Regarding independent claim 27, Appellant asserts that the
Specification "clearly supports the concept of multiple databases 60 which
receive error messages from particular printers based upon the type of
software programs running on such printers" (App. Br. 14).

Did Appellant demonstrate that the Examiner erred in finding that the
Specification lacks written description support of a printer running a first set
of software programs and a printer running a second distinct set of software
programs as recited in claim 27?

ISSUE 3

Appellant asserts that "Bernklau-Halvor fails to disclose a system
having an error database that receives error messages . . . [that] are
automatically generated and conveyed over a network to [at] least one online
error database upon detection of an error" (App. Br. 15).

Did Appellant demonstrate that the Examiner erred in finding that
Bernklau-Halvor discloses automatically generating and conveying an error
message upon detection of an error?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance
of the evidence.

1. The Specification discloses "[t]he ability to automatically gather actual information on common printer errors" (¶ [0005]).

2. The Specification discloses that "[i]f error detector 23 detects an error" (¶ [0028]), "[w]eb server 12 then uses microprocessor 20 to convey the error message to an online error database 60" (¶ [0029]).

3. The Specification discloses an embodiment in which "only printers of a certain model may convey error messages to one database" and "only printers running certain software programs may send error information to a particular database" (¶ [0032]).

4. Bernklau-Halvor discloses that a "user request support by accessing the printer driver" (col. 2, ll. 51-52), that "[t]he printer driver invokes the user's default browser" (col. 2, ll. 52-53), and that "[t]he printer's web server calls postscript functions which extract diagnostic data" (col. 2, ll. 56-58).

5. Bernklau-Halvor discloses that a "Usage Profile utility gathers usage information and printer status information during operation of the printer and stores it in a local memory" (col. 5, ll. 15-18).

6. Bernklau-Halvor discloses that "when a request for service is made to the supply server 12, the support server will request any usage profile information stored about the printer be sent to it for analysis" (col. 4, ll. 50-53).

7. Bernklau-Halvor discloses that the "Usage Profile database 116 is used to store the Usage Profile information submitted from the user's printer. In addition to PhaserSMART submitted Usage Profile

information, this database may also contain the Usage Profile

information submitted via email from printers" (col. 15, ll. 27-31).

PRINCIPLES OF LAW

35 U.S.C. § 112, first paragraph

To comply with the "written description" requirement of 35 U.S.C.

§ 112, first paragraph, an applicant must convey with reasonable clarity to

those skilled in the art that, as of the filing date sought, he or she was in

possession of the invention. The invention is, for purposes of the "written

description" inquiry, whatever is now claimed. *Vas-Cath, Inc. v. Mahurkar*,

935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

One shows "possession" by descriptive means such as words,

structures, figures, diagrams, and formulas that fully set forth the claimed

invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed.

Cir. 1997). The invention claimed does not have to be described in *ipsis*

verbis in order to satisfy the written description requirement. *Union Oil Co.*

v. Atlantic Richfield Co., 208 F.3d 989, 1000 (Fed. Cir. 2000).

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art

reference that discloses, either expressly or inherently, each limitation of a

claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm.*

Corp., 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

ANALYSIS

Issue 1

As set forth above, the Specification discloses automatically gathering (i.e., "generating") printer error information (FF 1, 2) and that if a printer error is detected, the web server conveys an error message to an error database (FF 2). Hence, the Specification discloses automatically generating printer error information and conveying the information to a database over a network and does not disclose a manual step of triggering either generating error information or conveying the information over a network to a database. In view of these specific disclosures, we disagree with the Examiner that the Specification fails to provide written description support for these claim limitations.

The Examiner finds that the disclosed process of conveying an error message if an error is detected "does not exclude possible intervening steps" (Ans. 6). However, the Specification does not disclose such intervening steps and explicitly discloses that the information is conveyed if an error is detected. Since the Specification provides descriptive words to set forth the claimed invention of automatically generating and conveying information upon detection of an error, and since the claimed invention does not have to be described in *ipsis verbis* in order to satisfy the written description requirement (*Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d at 1000), we agree with Appellant that the Specification provides ample support for the disputed claim feature, as recited in claims 7-15, 21, 23, 24, and 26.

Accordingly, we conclude that Appellant has met the burden of showing that the Examiner erred in rejecting claims 7-15, 21, 23, 24, and 26.

Issue 2

As set forth above, the Specification discloses conveying error information from printers to certain database based on the model of the printer or based on certain software programs running on the printers (FF 3). The Examiner finds that "[t]he disclosure does not provide guidance on whether a different software program is associated with a different database" (Ans. 7). However, the Specification discloses that error information of printers running "certain software programs" are conveyed to certain databases and therefore appears to disclose different software programs associated with certain databases. We therefore disagree with the Examiner.

The Examiner also states that "[t]he specification is silent as to the exact permutations of the arrangement that would be available" (Ans. 7). As set forth above, the Specification discloses "permutations" in which different programs run on different printers and error messages are conveyed to different databases based on the programs running on the printers. However, even assuming the Examiner's statement to be true that "permutations" are not disclosed, we disagree with the Examiner that "exact permutations of the arrangement" are required to demonstrate that Appellant had possession of the claimed invention. Specifically, as described above, claim 27 recites a first printer running a software program and a second printer running a different software program and the Specification discloses different printers

running different programs and error messages being conveyed to different databases based on the programs running on the respective printers.

Accordingly, we conclude that Appellant has met the burden of showing that the Examiner erred in rejecting independent claim 27.

Issue 3

As described above, Bernklau-Halvor discloses storing printer data in a local memory (FF 5, 7), a user requesting the data from the local memory (FF 4), and, responsive to the user request, a server extracting the requested data from the data store (FF 6). However, the Examiner has not demonstrated that Bernklau-Halvor also discloses that the extracted data is "automatically" conveyed to a remote database "upon detection of an error" or "in response to detection of" the error, as recited in claims 21 and 26. Rather, Bernklau-Halvor appears to merely disclose storing data in a database and extracting the data upon request by a user.

The Examiner finds that Bernklau-Halvor discloses automatically conveying messages in response to detection of the error because the "printer information had to be previously stored . . . in database 116 in order to be available to be supplied after the request" (Ans. 9). While we agree that information extracted from a database must have been previously stored in the database (in order to be subsequently extracted from the database), we do not follow the Examiner's reasoning as to how this fact demonstrates that Bernklau-Halvor discloses automatically conveying messages in response to detection of the error, particularly since, as the Examiner points out, the data

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is extracted from the database "after the request" (from the user) rather than "automatically" and "in response to detection of the error"

Accordingly, we conclude that Appellant has met the burden of showing that the Examiner erred in rejecting claims 21 and 26.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has demonstrated that the Examiner erred in:

1. finding that the Specification lacks written description support of automatically conveying an error message over a network in response to detection of the error,

2. finding that the Specification lacks written description support of a printer running a first set of software programs and a printer running a second distinct set of software programs, and

3. finding that Bernklau-Halvor discloses automatically generating and conveying an error message upon detection of an error.

DECISION

We reverse the Examiner's decision rejecting claims 7-15, 21, 23, 24, 26, and 27 under 35 U.S.C. § 112, first paragraph, and claims 21 and 26 under 35 U.S.C. § 102(e).

REVERSED

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